

REMARKS

This application contains claims 1-47, the status of which is as follows:

- (a) Claims 2-27 were previously canceled without prejudice.
- (b) Claim 1 was previously amended, and claims 28-29 and 31 were previously added.
- (c) Claim 30 has been currently amended.
- (d) Claims 32-47 are new.

No new matter has been added. Reconsideration is respectfully requested.

Amendments to the specification

Paragraph [0042] of the specification has been amended to correctly recite the application number of US Provisional Application 60/107,479. This application number was correctly recited in the priority claim as originally filed of the parent application (US Application 09/831,100, which issued as US Patent 6,725,093), and of the international application of which the parent application is the US national stage (International Application PCT/IL99/00594, which published as PCT Publication WO 00/27476). The Applicant notes that this correction was previously made to paragraph [0001] of the specification in the amendment filed March 10, 2004.

New claims and amendments

Claims 32-47 are new. These claims are identical to claims 2-6, 10-15, 17, and 21-24 as originally filed (and subsequently canceled by preliminary amendment), except that claims 37-38 and 44-46 do not include the multiple dependencies of the claims as originally filed. Claim 30 has been amended to depend from claim 39 instead of claim 12. Claim 39 is identical to claim 12 as originally filed.

Obviousness-type double patenting

Claim 1 was rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of US Patent 6,725,093. While not necessarily agreeing with the rejection, the Applicant is filing a terminal disclaimer in order to expedite issuance of a patent.

Claim rejections under 35 U.S.C. 112

Claims 30 and 31 were rejected under 35 U.S.C. 112, second paragraph, because they improperly depended from canceled claims. Claim 30 has been currently amended to depend from claim 39, which replaces canceled claim 12, as described above.

Claim rejections under 35 U.S.C. 102

Claims 1 and 28 were rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,292,693 to Darvish et al. The Applicant respectfully traverses these rejections. The Examiner argued that the '693 patent is available as prior art because it claims priority from US Provisional Application 60/104,479, filed October 16, 1998, which predates the foreign priority claim of the present application.

The Applicant first notes that the earliest priority claim of the present application is to US Provisional Application 60/107,479, filed November 6, 1998. The Applicant is separately filing a request to correct the filing receipt.

The priority claim in the '693 patent to US Provisional Application 60/104,479 contains a typographical error. The correct application number is 60/107,479, filed November 6, 1998. The Applicant's representative, who also represents the assignee of the '693 patent, is separately filing a request for a certificate of correction to correct this priority claim. US Provisional Application 60/104,479 (entitled, "Method for defining receptor protein kinase induced patterns of gene expression") cannot serve as the basis for a proper priority claim because this application does not share any common inventors with the '693 application.

If such a certificate of correction ultimately is not issued, the earliest "102(e) date" of the '693 patent is its filing date, March 2, 1999, which is after November 16, 1998, the date of the foreign priority claim of the present application to Israel application 127,092. All of the claims of the present application are supported by the disclosure of the foreign priority application, so the '693 patent cannot serve as prior art against the present application.

If such a certificate of correction ultimately is issued, to the extent that US Provisional Application 60/107,479 provides support for the subject matter cited by the Examiner in the '693 patent, the provisional application also provides support for the claims of the present application, which, as mentioned above, claims priority from this provisional application.

The Applicant therefore submits that all of the claims pending in the present application are in a condition for allowance, regardless of whether a certificate of correction is issued for the '693 patent. There is thus no reason to delay the issuance of a notice of allowance for the present application until a decision is made regarding the issuance of the certificate of correction.

The Applicant believes the amendments and remarks presented hereinabove, and the filing of the terminal disclaimer mentioned hereinabove, to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments, remarks, and terminal disclaimer, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

Respectfully submitted,

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William H. Dippert
William H. Dippert
Registration No. 26,723

Wolf, Block, Schorr & Solis-Cohen LLP
250 Park Avenue
New York, New York 10177-0030
Telephone: 212.986.1116
Facsimile: 212.986.0604
e-Mail: wdippert@wolftblock.com